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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/656,836 | 09/08/2003 | Julien Lefebvre | 2201.0010001/RWE | 8398 |
| 26111 | 7590 | 10/19/2005 | EXAMINER | |
| STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | NAKARANI, DHIRAJLAL S | |
| | | | ART UNIT | PAPER NUMBER |

1773

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/656,836 | Applicant(s) LEFEBVRE ET AL. | |
| | Examiner D. S. Nakarani | Art Unit 1773 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-15 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to:
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 01 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8/1/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election of Group 1, claims 1-12, in the reply filed on August 1, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support for Mxsite™ as being "a polyethylene cling resin comprising amorphous polyolefin" in claims 1 and 5, lines 2-3; and Dow 494™ as being "linear low density polyethylene" in claim 9, line 2. The Examiner is unable to find support for these changes in the originally filed specification and also in Somers et al (U. S. Patent 6,070,394) as stated by applicant. Applicants have not pointed out where the support can be found in the original specification. In absence providing support those changes constitute new matter. As per Eastman's Material Safety Data Sheet of Mxsite™, the

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Mxsite™ is a polyethylene cling resin. The Material Safety Data Sheet of Mxsite™ does not show that the Mxsite™ polyethylene cling resin comprises amorphous polyolefin.

Therefore afore said changes is a new matter.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghiam et al (U. S. Patent 6,326,081 B1) in view of Eichbauer (U. S. Patent 6,093,480) for the reasons of record set forth in paragraph 15 of the Office Action mailed March 13, 2005 (Paper No. 20050319). In addition, Ghiam et al's smooth layer forming polyethylene containing octene monomer units deemed to have some amount of amorphous polyolefin unless shown otherwise. Ghiam et al's production method is a co-extrusion (Col. 5, lines 57-67). Ghiam et al's method of protecting surface of substrate comprises step contacting the surface of substrate with the masking film. Ghiam et al's substrate include, polycarbonate, acrylics, polyester, glass etc (Col. 6, lines 1-14). Thus Ghiam et al's method of manufacturing masking film and method of protecting a surface of a substrate meets claimed methods in claims 13-15.

6. Applicant's arguments filed August 1, 2005 have been fully considered but they are not persuasive. In reference to rejection of claims 1-12 as being unpatentable over Ghiam et al (U. S. Patent 6,326,081) in view of Eichbauer (U. S. Patent 6,093,480),

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applicants mainly argue that Ghiam et al does not disclose a masking film comprising a first outer layer consisting of a polyethylene cling resin comprising amorphous polyolefin and second outer layer that does not contain the polyethylene cling resin, wherein the first outer layer of the film is adapted for retackably adhering to a surface of a substrate as recited in present claim 1. Eichbauer is directed to stretch wrap films, not masking films for adhesion to smooth surfaces. The various layers of the stretch wrap films in Eichbauer have a cling force relative to each other, not relative to a separate smooth substrate. The ordinarily skilled artisan would not have been motivated to utilize any of the polymeric cling resins disclosed in Eichbauer in the masking films of Ghiam et al, as the two disclosures are directed to two unrelated polymeric-film technologies.

These arguments are unpersuasive because there is nothing on record showing that Ghiam et al's first layer forming polyethylene containing octene comonomer is not a polyethylene cling resin comprising amorphous polyolefin. Eichbauer is only used for showing composition of the core layer and the second layer and not for the first layer as argued. Further more the specification as filed does not provide support for Mxsite™ as being polyethylene cling resin comprising amorphous polyolefin.

7. Receipt of Information Disclosure Statement filed August 1, 2005 is acknowledged and has been made of record.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. S. Nakarani
Primary Examiner
Art Unit 1773

Dsn
October 13, 2005